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IN THE
Supreme Court of the United States

OCTOBER TERM 1937

No. 72

CROWN CORK & SEAL COMPANY, INC., *Plaintiff-Petitioner,*

v.

FERDINAND GUTMANN & COMPANY, *Defendant-Respondent.*

**SUPPLEMENTAL REPLY BRIEF FOR PLAINTIFF-
PETITIONER ON THE DEFENSE THE PATENTS
IN SUIT DO NOT DISCLOSE INVENTIONS OVER
THE PRIOR ART.**

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TABLE OF CONTENTS.

	Page
Foreword	1
Prior Attempts to Make Spot Crowns Commercially..	3
The White Rock Crown	3
The "American" Type of Spot Crown	3
New Process Company's Unsuccessful Efforts.....	4
International Company's Attempts To Make Spot Crowns	5
Johnson's Efforts	6
Petitioner's Discarded Slide Machine	6
The History of the Prior Art Shows That Although There Was a Demand for Center Spot Crowns the Efforts to Produce Them Were Only Failures.....	7
The Prior Art Relied Upon by Respondent Does Not Anticipate the Warth Method	10
Warth's Alleged Admission of Lack of Novelty..	11
Prior Patents on Cork Disc Assembly Machines Do Not Anticipate the Warth Patents.....	12
Defendant's Argument of Want of Invention	13
Respondent's Reference to Prior Patents on Center Spot Caps	15
Petitioner's Discarded "Slide" Machine Does Not An- ticipate the Warth Patents	16
The Warth Patents Do Not Cover a Mere Function of a Machine	18

TABLE OF CASES CITED.

Buffalo Forge Co. v. City of Buffalo, 205 F. 83, 87, (C. C. A. 2)	18
Expanded Metal Co. v. Bradford, 214 U. S. 366.....	18
Loom Co. v. Higgins, 105 U. S. 580, 591, 592.....	11
Michigan Carton Co. v. Sutherland Paper Co. (C. C. A. 6th), 29 F. (2d) 179	18
Paramount v. American, 294 U. S. 464	8
Parks v. Booth, 102 U. S. 96, 104	11

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This brief is directed solely to respondent's defense that the two Warth method patents in suit are invalid because their disclosures are not inventions in view of the prior art (Resp. Br. p. 47-53).

Foreword.

For an understanding of the Warth patents and their relation to the prior art, it is necessary to appreciate the demand which arose for spot crowns before the inventions were made, the problems involved in the manufacture of spot crowns and the unsuccessful efforts made by skilled workers in the art to satisfy that demand over a period of

many years prior to Warth's successful solution of the problem.

While it is true that crown caps having center spots adhesively united to the cork were suggested in patents at least as early as 1914 (Demuth British Patent 16,075, III—1628), **that left the real and vital problem of cheap, i. e., high speed manufacture, wholly unsolved.**

Center spots for crown caps are particularly desirable for use with caps in which the cork disc is made of so-called "composition cork"; that is, small particles of cork held together by some form of adhesive binder. These composition discs are very much cheaper than discs cut from natural cork. But for many liquids composition cork is unsuitable, due to its tendency to disintegrate and to impart taste to some beverages (I, 354). The use of composition cork for crown caps was known at least as early as 1908 (Jones patent, III, 1634) and since an adhesively held center spot which would enable the use of a composition cork was known at a very early date, the remaining problem was to devise a method by which center spots could be applied to crown caps with composition cork discs (1) *accurately*, (2) *securely*, and (3) *at high speed* (I, 130).

In order to be successful the center spot must be accurately centered on the cork disc. If it is not, it may extend over the entire surface of the neck of the bottle at one side and thus permit leaking, and at the other side would permit the bottle contents to contact with the cork. (See the drawing opposite p. 2 of our Main Brief.)

Moreover, it is not sufficient merely to have the spot *loosely* adhering to the cork. It must closely adhere to the cork, particularly around the edge of the spot, so that it will not be dislodged in the hopper of the capping machine (I, 502), by which machine the caps are applied to the filled bottles at as high a rate as 160 per minute (I, 55).

Finally, it is vital that the spot crowns be made *cheaply*, i. e., *at high speed*, to meet the competition with other forms of corking.

By Warth's patented methods, petitioner is now applying these spots to crowns at the rate of *500 per minute* for each operating unit (I, 64).

Today, thanks to the inventions of the Warth patents in suit, spot crowns are made and sold in tremendous amounts and at a price which seems almost incredible. They sell at from 22 cents to 24 cents a gross (that is, about 6 for one cent), this cost including not merely the center spots, but the entire crown, consisting of the shell with its ornamental printing, the composition cork disc and the center spot (I, 58).

Petitioner's sales are at the annual rate of about nine million *gross* of center spots, which is about thirty per cent of its entire crown production.

Prior Attempts to Make Spot Crowns Commercially.

THE WHITE ROCK CROWN.

This crown, also known as the "Stewart," has been used by the White Rock Company since 1914 (I,) and is illustrated on Exhibit 17 (III, 1600). Only metal foil can be used for the spot, and this limits its use since metal is attacked by acidulated beverages such as gingerale.

The edge of a circular piece of foil is turned up to form a cup, this edge being inserted in a circular slit in the cork, the spot being held mechanically by this inserted edge, and not adhesively, to the cork.

The cutting of the slit necessitates the use of expensive natural cork since composition cork cannot be used.

This type is used only by the White Rock Company and possibly a few others. Though expensive, it is a commercial spot crown but it is entirely foreign to the adhesively-held spots involved in this suit.

THE "AMERICAN" TYPE OF SPOT CROWN.

This is also illustrated on Exhibit 17. Attempts to commercialize it failed and it is not now on the market. Instead of cork, the "cushion" was a rubber ring and the center

member, analogous to a center spot, was a cup-shaped piece of foil with the cup extending into the center of the rubber ring with its edges over the rubber ring, to hold the latter in place. The center of the cup was soldered to the metal of the shell of the cap.

Weisenburg attempted to make this "American" crown in 1916, but was unable to do so commercially (I, 60). Wagner, a former employee of the American Company, tells of its troubles with this crown (I, 427).

NEW PROCESS COMPANY'S UNSUCCESSFUL EFFORTS.

McManus, formerly president of the New Process Company, and now petitioner's president, a man highly skilled in the art and an inventor of standing, attempted to make center spot crowns commercially from 1915 to 1926 (I, 346). He used the facing material of his patent 1,213,926 (1118) and the machine of his patent 1,402,780 (1177). McManus tried paper center spots, with glue and gelatine as the adhesive, and tinfoil spots with an adhesive-coated paper between the foil and the cork (I, 343). He also tried (I, 345) the heat fusible cement mentioned in his patent 1,339,066 (I, 530) and which had been previously employed to unite the cork disc to the shell, but this also was unsuccessful.

In his commercial attempts, McManus used a water-soluble glue and moistened the surface of the cork before placing the glue side of the spot thereon. Though his machine centered the spot initially, a large percentage of them "floated" off center before the adhesive could dry, especially if the machine ran at any high rate of speed (I, 344). His limit was about 40 a minute and the method was costly. McManus' paper spots were parchment and this wrinkled (I, 345) permitting moisture to get through the paper to the cork, spoiling the contents and causing the spots to come off in the bottle (I, 345). The adhesive for the tinfoil spots was also water-soluble and they were subject to much the same manufacturing difficulties as paper.

In spite of double inspection to remove the "off-center" spots, McManus was obliged, in about 90% of the cases, to make adjustments for defective crowns (I, 344) and in the ten years from 1916 to 1926, he sent out no more than possibly 100,000 gross, most of which were tinfoil¹ (I, 346).

INTERNATIONAL COMPANY'S ATTEMPTS TO MAKE SPOT CROWNS.

Defendant's witness Alberti (I, 126, 131), and plaintiff's witness Marsa (I, 353-356) tell the story of the repeated efforts of the International Cork Company over a period of eleven years to manufacture spot crowns in which the center spot is adhesively united to the cork. Their experimenting began early in 1914, and continued until 1925 (I, 354) during which they expended from twenty-five to thirty thousand dollars (I, 356). They always used *wet, heat-set* albumen as the spot adhesive. Several machines were built, culminating in the machine of the Alberti patent 1,401,300 (III, 1449) which was finally abandoned (I, 182). Yet respondent relies upon this patent to anticipate the Warth invention. Alberti was unable to overcome the difficulties involved in producing at high speed which he says was essential for commercial production (I, 130). Clean and saleable spot crowns could not be produced by this machine. With insufficient glue, the spot would not adhere at its edges. With too much glue, bubbles formed at the edges.

The spots could not be accurately centered, and were always on "one side or the other, which would leave the cork exposed to the beverage" (I, 355).

The Alberti machine never left the experimental room and was run at only 40 to 50 caps per minute. Though carefully selected caps were submitted to customers, there were no orders and the experiment was abandoned after

¹ Nagy, for respondent, said (I, 141) that, when he worked for McManus' company in 1916, "It took about a week at that time to make 200 gross and the machine was working steady." Today, using the method of petitioner's patents, Nagy's machines have that output in about 2½ hours (I, 146).

a couple of years and the expenditure of several thousands of dollars. Respondent's witness Alberti says (I, 126) that "along in 1913, '14, '15 and '16", there were no successful center spot crowns except the White Rock, although repeated attempts to manufacture them were made by his company, International Cork Co., also by the New Process Cork Co., and by others.

JOHNSON'S EFFORTS.

Johnson's application for his improperly-issued patent (I, 583) was not filed until November 26, 1929. This was after he had been to petitioner's plant and observed the operation of Warth's method. Johnson had been an inventor and builder of assembling machines for thirty-three years (I, 160). He had been working since 1927 (I, 167) to develop a method for applying spots to crowns, yet as late as the Fall of 1928, after he had sent out unsatisfactory machines to Armstrong and to respondent (I, 213), he was still experimenting (I, 173).

PETITIONER'S DISCARDED SLIDE MACHINE.

This machine is referred to in the decision of the Court of Appeals and is described in our Main Brief (pp. 41, 43). Aside from the White Rock crown (p. 3, *ante*), practically the only commercial center spot crowns were manufactured in petitioner's plant by this machine and the steps employed are illustrated in the drawing opposite page 41 of our Main Brief. Although three of these machines were used for several years by petitioner, the method it employed made manufacture extremely slow and not more than *fifty* or *sixty* caps a minute were produced (I, 371). The method was a constant source of trouble for the reason that the disc did not always fall centrally in the slide and the spot would be picked from the slide so that it could not be properly deposited on the crown by the plunger which heated the spot before it was deposited (I, 371). Although peti-

tioner was constantly at work on the machine over a period of nine years, they never produced satisfactorily (I, 371).

The contrast between the Warth method and that of the slide machine is evident from the fact that by the Warth method the speed of production of petitioner's machine was increased to 420 per minute (I, 372). Subsequent improvement still further increased the speed to over 500 per minute, using the same Warth method.

The History of the Prior Art Shows that Although there was a Demand for Center Spot Crowns the Efforts to Produce them were only Failures.

Aside from petitioner's production of center spot crowns by its so-called "slide" machine, which production was small compared to its production after the introduction of the Warth method (II, 607), there was no manufacture of spot crowns having the center spots adhered to the cork. The efforts of McManus, Alberti, Johnson and others to produce a satisfactory method of manufacture shows the demand over a period of ten years (1915-1926) for a method which would satisfy the requirements of the industry, namely *high speed* production of crowns having the center spots *accurately* and *permanently* adhered. Weisenburg, who had been in the crown cap business since 1916 (I, 52) stated (I, 84) that although there seemed to be no great sale of spot crowns prior to 1927 or 1928,

"there was a great need for them but we did not know how to make them."

Again, Marsa, formerly with the International Company, explained that their continued unsuccessful efforts to make spot crowns, were prompted by their "**feeling at that time * * * if we could get a thing like that we would make a killing with it.**"¹ (I, 354).

McManus also appreciated the demand for center spot crowns and this demand was the reason for his unsuccessful efforts from 1915 to 1926. He said (I, 346):

¹ Emphasis ours throughout unless otherwise stated.

"I had always felt * * * that if anybody could develop a commercial center spot crown, there would be a very large market for it, and it would probably replace the large volume of natural cork that was done by Crown Cork & Seal Company at that time."

All of these prior attempts at "spotting" crowns were failures commercially and none solved the real problem of cheap (and therefore high-speed) production with accurate centering and close adherence of the spot to the crown.

The White Rock Crown was and is a success as a crown, but it is so expensive that, with the exception of one company, it has not gone into use, although all of the patents therein have expired long ago. The primary reason is that this type of center spot cannot be used with composition cork.

The American Company's attempt to solve the problem by using a complicated cap construction was a failure.

The attempts of International and McManus were either outright or practical failures.

While petitioner's slide machine method gave results of a sort, it certainly did not solve the problem of cheap production.

These attempts of large companies and highly skilled men over a long period of years and with ample capital to develop a satisfactory method to meet an obvious call for a spot crown, show that something more than mechanical skill was required to solve the problem.

The Warth invention is clearly of the class mentioned in *Paramount v. American*, 294 U. S. 464, in which the Court said (at 474):

"Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want. (Citing) *Loom Co. v. Higgins*, 105 U. S. 580, 591; *Krementz v. Cottle Co.*, 148 U. S. 556, 560; *Hobbs v. Beach*, 180 U. S. 383, 392; *Carnegie*

Steel Co. v. Cambria Iron Co., 185 U. S. 403, 429, 430;
Expanded Metal Co. v. Bradford, 214 U. S. 366, 381."

Warth's method is described in our Main Brief, pp. 4-6, and we will not repeat that description of it.

Warth's solution was based on his perception of how to overcome the trouble which arose primarily because of the speed with which the spotting must be done if there is to be cheapness of production.

To pick up a spot by hand and glue it to a crown in a laboratory way would not be more difficult than sticking a postage stamp on a letter. But when this is attempted mechanically, an intermittent operation results in which the crown to be spotted is moved step by step through the various operative stations. If the rate is even as low as 240 per minute, that means that each crown is started, moved to the next station and stopped in its new operative position, *all in one-fourth of a second*. This motion resolves itself into a series of short, sharp, rapidly-recurring jerks.

Yet in that split-second, the spot must be cut out and accurately centered in the cork and be stuck so firmly as not to be displaced when the crown is jerked to its next station.

With Warth's teaching now as part of our knowledge, it is now relatively easy to see why the prior art failed. For instance, it is now obvious that a wet adhesive will not do because, even if the spot is originally placed accurately on the crown, the wet and still slippery adhesive will not hold it there with such certainty as to prevent displacement as the crown is jerked along while the adhesive is drying. That was the trouble McManus and International experienced with their water soluble adhesives.

Again, it is now obvious that it will not do to punch out the spot at one point and then carry it to another point for application. The spots are small and wafer-thin and, if the rate is to be even 240 per minute, the impossibility of carrying the wafer from one point to another in one-quarter of a second is clearly going to be difficult, if not impossible.

Again, it is now obvious that a thermoplastic adhesive, like gutta percha, will not be slippery, like the wet adhesive, and will be a good adhesive if properly handled. But, because it becomes so "sticky" when heated, it must be handled so as not to receive its heat before the time of application to the cork.

Again, it is now obvious that the adhesive and the spot material should be made integral or unitary, by coating the adhesive on the strip material instead of using *separate* strips of spot material and gutta percha.

This, we can now see from Warth's teachings, will be accomplished:

(1) *if the gutta percha is pre-coated in the strip of spot material before the spot is punched out, for then the spot will surely have adhesive over its entire area,*

(2) *if the adhesively coated spot is punched out just above the cork so that the punch will carry the spot immediately into its final position,*

(3) *if the heat is not applied to the adhesive until the spot is applied to and pressed on the cork; that is, in the language of the Warth patent, upon or at the instant of assembly, and*

(4) *if the spot is held under pressure while cooling.*

The Prior Art Relied upon By Respondent Does Not Anticipate the Warth Method.

It is also now relatively easy to go back through the prior art and pick out one part of Warth's method from one place and another from another place. By combining these fragmentary disclosures, respondent attempts to anticipate the Warth patents.

But that is wisdom after the event and the courts have frequently condemned such piecemeal building-up of a successful invention from the prior art.

"Where the thing patented is an entirety, consisting of a separate device or of a single combination of old

elements incapable of division or separate use, the respondent cannot make good the defense in question by proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant." *Parks v. Booth*, 102 U. S. 96, 104.

"It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention. It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty; and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent." *Loom Co. v. Higgins*, 105 U. S. 580, 591, 592.

The numerous workers in the art had the same suggestions before them and yet they did not see how such suggestions could be utilized to accomplish Warth's result. Otherwise, the art would not have waited for Warth's method which is now the one universally used for making spot crowns (I, 68).

Warth's alleged admission of lack of novelty.

Respondent refers to (Br. p. 50) to a statement in an abandoned Warth application (III, 1731), filed before the patents in suit, to the effect that "apparatus for cutting and assembling spot centers is known in the art." This we do not deny. Presumably, Warth was referring to the slide machine described in our Main Br. p. 41, and illustrated in the drawing opposite that page. Obviously, that machine has nothing to do with the methods of the patents in suit, and, therefore, the statement quoted from the Warth application is not an admission that apparatus for practicing the **methods of the patents in suit** was old prior to his invention.

Prior patents on cork disc assembly machines do not anticipate the Warth patents.

Respondent then refers (Br. p. 48) to a number of patents having to do with *machines for inserting cork discs in the metal shells*. These machines show various ways of adhering the cork disc to the shell.

Respondent's entire argument based on these "cork disc assembling machine" patents is based on the false premise that Warth's claimed method is merely the simultaneous application of heat and pressure and that heat and pressure may be applied at any suitable stage in the operation.

On the contrary, not only is the claimed method a complete one consisting of a *succession and combination* of steps, but it is further limited to the stage where the heat and pressure are applied *to the spot*. The drawing opposite page 5 of our Main Brief shows that the claimed method involves the following:

First, a strip coated with thermoplastic adhesive is positioned beneath a punch and over a crown.

Second, the punching operation is utilized to deposit the spot upon the crown in central position.

Third, the heat and pressure are utilized or made available at the instant of assembly, or, as the claim states it, "upon assembly applying simultaneously" the heat and pressure.

Fourth, the crown is cooled under pressure (claim 3, Main Br. p. 4—footnote).

While each of the steps is vital, as petitioner's witness puts it (I, 67):

"This last (Third, *supra*) step of applying both heat and pressure instantly with assembling serves the useful purpose of positioning the center spot centrally in the cap and enables it to stay put until further operations can be performed. This must be done instantly. Where you are running a machine at 500 per minute there is no time to wait, and one must be sure that the spot is centrally positioned.

"The use of heat and pressure instantly with deposit of the spot might be considered the keynote of the entire operation. However, the three steps are like, I might say, the three steps of a tripod. Without any one of the steps the method will not function."

Defendant's Argument of Want of Invention is Unsound.

Starting with its false premise referred to above, defendant claims to find the step of simultaneous application of heat and pressure in the very old art of assembling the cork discs in the metal shells in making non-spotted crowns, and then, from that, argues Warth's center-spotting method was obvious.

But that old cork disc assembling art differs essentially in its procedure.

(1) There was no problem of *centering* as there is in the spotting art, *since the cork disc fitted tightly* within the metal shell.

(2) Nor was there any punching operation, since the discs were preformed.

(3) Nor was there any necessity for the adhesive to cover the entire area of the two surfaces joined.

(4) Finally, and most important of all, there was no necessity for having the adhesive unite the two surfaces *at the instant they were brought together*, since the cork disc was not free to shift in the closely fitting shell.

Because of the simple requirements of the old art of inserting a cork disc in a shell, it was sufficient to drop some adhesive, either separately or on a paper disc, into the shell and then insert the cork disc. It was wholly immaterial whether the pressure was applied to the cork disc before, during, or after the heating of the adhesive *since there was no problem of centering the cork disc*. Each of these variants is shown in some of the patents on which defendant relies (Br. 48).

In contrast, when applying the *center spot* by the Warth method, it is essential (1) that the spot be punched out of

an adhesive-coated strip (2) that the punching operation be directly over the cork disc so that the spot will be placed immediately on the cork by the punch, (3) that the heat and pressure be applied to the adhesive on the spot "*upon*" or *at the instant of assembly* of the spot with the cork disc and (4) that the spot be held under pressure while cooling.

By this, the spot is not only correctly centered but it is positively adhered at the instant it is deposited. Since the spot is adhered in the Warth method at the instant it is deposited, it does not shift from position as the caps are rapidly stepped to the following positions for subsequent operations. When it is borne in mind that the crown shells are moved to and past the punching station, step by step at the rate of over 500 per minute, it is not difficult to appreciate the constant jarring of the shells which tends to dislodge and move the deposited spot.

By his method, Warth has solved the problem of *accurately centering* the spot and *permanently adhering* it, while at the same time permitting the *high speed manufacture* which is essential if the cap is to be manufactured commercially.

The best proof that nothing in the crown assembly art teaches the Warth method is to be found in the failures of prior inventors and workers, all of whom were familiar with cork disc and metal shell assembling machinery. Consequently, the practical history of the development of the Warth method, as shown by the inventors who sought unsuccessfully to provide an efficient method of manufacture, completely answers respondent's assertions that the Warth method is obvious from the prior art.

Respondent's arguments as to what skilled workers *might* deduce from the prior art is answered by the *fact* that those who sought to make use of this art failed in their efforts. Only Warth succeeded.

Respondent's Reference to Prior Patents on Center Spot Caps.

None of the spot crown patents cited by respondent (Br. pp. 48, 49) suggests a method of manufacture similar to Warth's.

The McManus patent 1,339,066 (I, 530) states:

"Accuracy in the positioning of the disc *f* [center spot] in the commercial production of caps * * * may be secured mechanically in a number of different ways and by means of a variety of different mechanisms and the manner of assembling * * * is immaterial to the invention * * *"

As we have already shown (p. *ante*), when McManus sought to produce this cap commercially, he failed, although he had spent much time and money in his efforts.

Respondent's black lettered quotation from the McManus patent 1,339,066 (Br. p. 49) is grossly misleading, **since the quoted reference to the application of heat and pressure has nothing whatsoever to do with applying the spot to the crown.** The quotation refers only to the assembly of the *cork disc* with the shell and this involves no similar problems as we have shown. Moreover, the statement quoted from the McManus patent that in uniting a cork disc and shell, heat and pressure may be applied "simultaneously or successively" says nothing more than what is described in the assembly machine patents discussed pages 12-14 *ante*, and shows that in this procedure it is immaterial how or when the heat and pressure be applied. Yet respondent's use of the quotation would mislead the Court to believe that the patent there refers to a method of "spot" application.

Respondent's entire discussion of this and other patents infers that the Warth method consists simply in the step of using heat and pressure, regardless of how and when heat and pressure are applied. But we have shown that the Warth method is a *combination of steps*, involving among others the step of applying simultaneously heat and pres-

sure at the instant the spot is deposited. There is certainly nothing in any of the patents which respondent cites suggesting even this step alone or that it would be useful in center spotting.

Petitioner's Discarded "Slide" Machine Does Not Anticipate the Warth Patents.

Respondent finally refers (Br. 51) to the slide machine which was discarded upon the development of the Warth method. The operation of this machine is described in our main brief (p. 41) where we have inserted a drawing showing the successive steps followed in the use of that machine as to which the District Court found (III, 1790):

"The combination of steps defined in the Warth methods of the patents in suit are not found in the plaintiff's first or slide machine, and it does not anticipate."

We have also shown in our main brief (pp. 41, 42) that the slide machine did not employ the combination of steps claimed in the Warth patents. Respondent seizes upon **one detail** of the operation of the slide machine, namely, the heated suction plunger by which the spot is lifted from the slide and heated *before* it is deposited on a crown and, because of this feature, argues that the slide machine is a complete anticipation of the entire Warth method. If the Warth method consisted merely in the use of heat and pressure, respondent's contention would be in point. But Warth's procedure involves much more than this as we have already shown.

The contemporaneous description of the slide machine (II, 613) from which respondent partially quotes (Res. Br. p. 52) explains the *entire operation* of the slide machine and shows that the *combination* or sequence of steps followed by that machine was essentially different from the combination of steps followed by Warth as we point out in our main brief (p. 42):

In the slide machine:

First. The spot was not formed from a strip coated with thermoplastic adhesive. On the contrary, *separate*, superimposed strips of metal foil and gutta percha were fed beneath a punch and the punching operation was used to unite the two separate discs formed as the punch descended.

Second. The punching operation did not deposit the spot (discs of foil and gutta percha) upon the crown. Instead, the punch deposited the discs in a slide which upon lifting of the punch, moved the two discs beneath the suction plunger.

Third. The adhesive (gutta percha) was not softened *upon or at the instant of assembly* of the spot with the crown. Instead, the gutta percha disc with the foil was rendered tacky while being held in raised position by the suction plunger.¹

Fourth. The spotted crown was not held under pressure while cooling. Instead, it was discharged from the machine as soon as the plunger lifted.

Therefore, it is clear that the slide machine had in common with the method developed by Warth only the fact that a single element (suction plunger used to lift from the slide and heat the spot before it was deposited) applied pressure to the spot, as well as continued heat, when the spot was deposited

If the Warth method was obvious from the slide machine, as respondent asserts, it is strange indeed that petitioner struggled for nine years with that machine notwithstanding the evident demand for center spot crowns produced efficiently. Moreover, respondent's reliance on this machine

¹ As stated in the contemporaneous description (II, 613), "While the Tin Foil Spot and Tissue are being retained by the heater 'H' [heated suction plunger] the Gutta Percha Tissue is being heated; * * *".

to anticipate the method by which it was superseded as soon as Warth disclosed his invention to petitioner, completely overlooks the fact that the Warth method provided the solution to the problem of high speed production which the industry had been seeking to solve for the previous eleven years (pp. 4-6, *ante*). Disregarding everything else the fact that the Warth method enabled petitioner to increase its production for each operating unit from the maximum of *sixty* caps per minute, obtained with the slide machine, to over *five hundred* caps per minute, is of itself a complete answer to respondent's contention that what Warth did was not an invention over the slide machine.

The Warth patents do not cover a mere function of a machine.

Respondent also asserts (Br. p. 52) that the claims of the Warth patents are "for a mere function of a machine."

It is true that the methods are best practiced with a machine, but from this there is no reason for concluding that they are not methods within the meaning of the statute. The fact that a machine is used for practicing the method does not invalidate a patent on the method as such. This Court finally settled that question in *Expanded Metal Co. v. Bradford*, 214 U. S. 366. See also *Buffalo Forge Co. v. City of Buffalo*, 205 F. 83, 87, (C. C. A. 2) in which the Court said:

"But that the means, and the only means of applying the process, are strictly mechanical is a matter of no moment, so far as patentability is concerned."

There are numerous cases in which method claims which refer to the use of a particular tool or instrumentality for practicing the method have been sustained. For example:

Michigan Carton Co. v. Sutherland Paper Co. (C. C. A. 6th), 29 F. (2d) 179.

The method of a claim in this latter case involved sealing cartons "by contacting with heated plates." The defendant contended that the claim distinguishes from the prior art processes only by including a "special form or arrangement of implement or apparatus"; but the court said (at 182).

"The claim has nothing to do with 'implement' or 'apparatus' for bringing the plates into contact with the surfaces to be glued. This particular process could be performed by hand or by different mechanisms than those disclosed by the machine claims. The disclosure is sufficient to enable any one skilled in the art to practice the process. It thus cannot be said that the claim involves 'nothing more than the operation of a piece of mechanism, or, in other words, for the function of a machine.'"

CONCLUSION.

The Warth patents clearly disclose inventions over the prior art and are valid.

Respectfully,

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